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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,267	10/24/2003	Mark V. Shoen	57111-5137	9077

7590 12/29/2004

ROD S. BERMAN, ESQ.  
JEFFER, MANGELS. BUTTLER & MARMARO LLP  
Seventh Floor  
1900 Avenue of the Stars  
Los Angeles, CA 90067

EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>10/693,267</p>	<p><b>Applicant(s)</b></p> <p>SHOEN, MARK V. <span style="float: right;">MS</span></p>	
	<p><b>Examiner</b></p> <p>James M Hewitt</p>	<p><b>Art Unit</b></p> <p>3679</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-24 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-24 and 26-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities:

On page 1, the status of application 09/567,999 should be updated.

Appropriate correction is required.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-24 and 26-38 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,779,943. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claims presented in the application constitute the logical and non-obvious corollary of the patented apparatus claims. And regarding the limitations added to claim 15, and those

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posited in claims 26, 30, 32 and 36, in view of the teaching of Blanchfield et al (see Figure 10), it would have been obvious to one having ordinary skill in the art to modify the claimed invention of the patent to employ the socket holes as claimed in claims 15, 26, 30, 32, and 36.

### ***Claim Objections***

Claims 15-24, 26-30, and 36-37 are objected to because of the following informalities:

In claim 15 line 2, "a" should be inserted before "coupling".

In claim 17 line 10, "halves" should be deleted.

In claim 26 line 16, "halves" should be replaced with "sections".

In claim 36 line 2, "sections" should be "section".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Winchester (US 3,380,267).

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Winchester discloses a method of preventing disconnection of an odometer cable coupling comprising the steps of: providing a device for shielding the coupling having a first section (5) and a second section (6) mateable with each other to form a cover for the coupling, the cover defining an opening therethrough, each section having a first flange extending from a first peripheral edge and a second flange extending from a second peripheral edge (see Figure 6), the first and second flanges of each section defining a cavity (see Figure 6); and fitting said first and second sections directly over said coupling, such that the coupling is partially enclosed in the cavity.

Claims 17-20, 22-23, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Corzine (US Re. 33,946).

As is clearly evident from Figure 3, Corzine discloses a method of preventing disconnection of a coupling using a device having first and second halves that are mateable to form an opening, a plurality of holes defined in said halves, the holes being aligned to receive fasteners. The flanges of the halves include the holes for receiving the fasteners. The flanges have been interpreted to be inclusive of those portions that enclose cage (10a), and thus define a cavity that partially encloses the coupling. The fasteners are allen screws.

Claim 24 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Corzine (US Re. 33,946).

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In the instance that the allen screws cannot be considered non hex-head fasteners, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a non hex-head fastener in place of the allen screws as a matter of design choice, and further in view of Applicant's statement that the threaded fastener may be any threaded fastener known and used in the art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 21, 30, 32-34, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corzine (US Re. 33,946) in view of Balnchfield et al (US 5,531,536).

Corzine teaches all the limitations of claims 15-16, 30, 32-34, 36 and 37, except that the socket hole has a length comprising a first diameter portion and a second diameter portion, the socket hole being enclosed along the first diameter portion and the second diameter portion, the first diameter being less than the second diameter, and the socket hole is defined in one of the first and second halves such that the first diameter portion is proximate the inner surface of one of the first and second halves. Blanchfield et al teaches, as is readily seen in

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Figure 10, a split coupling having a socket hole and a threaded hole defined in each coupling half. The socket holes have a length comprising a first diameter portion (64) and a second diameter portion (54), the socket holes being enclosed along the first diameter portion and the second diameter portion, the first diameter being less than the second diameter, and the socket holes is defined in one of the first and second halves such that the first diameter portion is proximate the inner surface of one of the first and second halves. In view of Blanchfield et al's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Corzine's device such that the socket holes have a length comprising a first diameter portion (64) and a second diameter portion (54), the socket holes being enclosed along the first diameter portion and the second diameter portion, the first diameter being less than the second diameter, and the socket holes is defined in one of the first and second halves such that the first diameter portion is proximate the inner surface of one of the first and second halves, and wherein a socket hole and threaded hole is defined in each coupling half, in order to provide an alternative means by which to fasten the two coupling halves together.

***Allowable Subject Matter***

Claims 26-27 would be allowable upon filing a compliant terminal disclaimer to overcome the above double patenting rejection and if rewritten to overcome the above noted claim objection to claim 26.

Claim 28 would be allowable upon filing a compliant terminal disclaimer to overcome the above double patenting rejection and if rewritten to overcome the above noted claim objection to claim 15 and in independent form to include all the limitations of claim 15.

Claim 35 would be allowable upon filing a compliant terminal disclaimer to overcome the above double patenting rejection and if in independent form to include all the limitations of claim 34.

Claim 38 would be allowable upon filing a compliant terminal disclaimer to overcome the above double patenting rejection and if in independent form to include all the limitations of claim 31.

### ***Response to Arguments***

Applicant's arguments with respect to claims 15-24 and 26-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

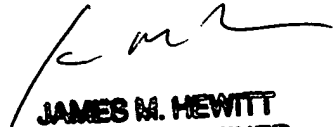
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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JAMES M. HEWITT**  
**PRIMARY EXAMINER**